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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,150	08/31/2000	Kazuhiro Hoshino	SON-1894	2607

7590 03/17/2006

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EXAMINER
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HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/652,150	<b>Applicant(s)</b> HOSHINO ET AL.	
	<b>Examiner</b> Nelson D. Hernandez	<b>Art Unit</b> 2612	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 28 February 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Response to Arguments. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 2 and 4-11.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Response to Arguments.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☒ Other: Attached PTO-892 form.



DAVID OMETZ  
 SUPERVISORY PATENT EXAMINER

## DETAILED ACTION

### *Response to Arguments*

1. In the Arguments filed on February 28, 2006, the Applicant argues the following:
  - a. Sako has a §371 (c)(1), (2), (4) date of February 22, 2000. However, the above-identified application is entitled to the benefit of the filing date for Japanese Patent Application No. 11-249473 having a filing date of September 3, 1999, and is entitled to the benefit of the filing date for Japanese Patent Application No. 11-3083 12 having a filing date of October 29, 1999. Both filing dates for the Japanese Patent Applications are earlier than the §371 (c)(1), (2), (4) date of Sako. Accordingly, Sako is believed to be unavailable as prior art and that the rejection of the claims using this reference should be withdrawn as a result. See M.P.E.P. §706.02(f)(1)(C)(3)(a) and M.P.E.P. §706.02(f)(1)(example 9).

The Examiner acknowledges the Applicant arguments indicating that the Sako reference cannot be used as prior art as explain in M.P.E.P. §706.02(f)(1)(C)(3)(a) and M.P.E.P. §706.02(f)(1). However, the sections indicated by the Applicant, are applied to references used under 35 U.S.C. §102(e).

M.P.E.P. §706.02(a)(2)(c) discusses that following:

Even if the reference is prior art under 35 U.S.C. 102(e), the examiner should still consider 35 U.S.C. 102(a) for two reasons. First, if the reference is a U.S. patent or patent application publication of, or claims benefit of, an

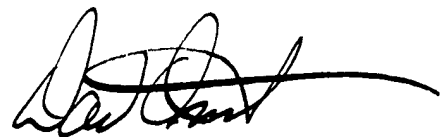
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international application, the publication of the international application under PCT Article 21(2) may be the earliest prior art date under 35 U.S.C. 102(a) for the disclosure. Second, references that are only prior art under 35 U.S.C. 102(e), (f), or (g) and applied in a rejection under 35 U.S.C. 103(a) are subject to being disqualified under 35 U.S.C. 103(c) if the reference and the application were commonly owned, or subject to an obligation of common assignment, at the time the invention was made. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work.

Sako (US Patent 6,724,503 B1) is claiming a priority of PCT WO99/12338, which is filed on August 29, 1997 and published on March 11, 1999, which is earlier than the filing date of the Japanese Patent Application No. 11-249473 having a filing date of September 3, 1999, and Japanese Patent Application No. 11-308312 having a filing date of October 29, 1999, so the Sako reference is considered as a §102(a) having a prior art date of March 11, 1999, which is the publication date of the PCT WO99/12338 as discussed in M.P.E.P. §706.02(a)(2)(c).

Therefore the request for reconsideration filed on February 28, 2006 does not place the application in condition for allowance.

2. The newly introduced **claims 12-16** raise new issues that would require further search. Therefore, the proposed amendments filed on February 28, 2006 will not be entered.



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